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10/524,423

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Mats Naslund

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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/524,423	<b>Applicant(s)</b> NASLUND ET AL.	
	<b>Examiner</b> JACOB C. COPPOLA	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-66 is/are pending in the application.
- 4a) Of the above claim(s) 64-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>14 February 2005 and 03 November 2006</u> . | 6) <input type="checkbox"/> Other: _____  |



## **DETAILED ACTION**

### ***Acknowledgements***

1. This action is in reply to the Restriction Election filed on 05 September 2008.
2. Claims 46-66 are currently pending and have been examined.
3. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. This Office Action is given Paper No. 20081014. This Paper No. is for reference purposes only.

### ***Restrictions***

5. Applicants’ election with traverse of claims 46-63 in the reply filed on 05 September 2008 is acknowledged. The traversal is on the grounds that dependent claims 61 and 62 would be searched by the Examiner in class 705, subclass 67, the same class and subclass noted by the Examiner for Invention II, claims 64-66. This is not found persuasive because Restriction Requirements are imposed by the USPTO on the basis of patentably distinct *independent* claims (see MPEP §800).
6. The requirement is still deemed proper and is therefore made FINAL.

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7. Claims 64-66 are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicants timely traversed the restriction requirement in the reply filed on 05 September 2008.

***Information Disclosure Statement***

8. The Information Disclosure Statements filed 14 February 2005 and 03 November 2006 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 46-63 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

11. Regarding claims 46-63:

a. These claims recite “performing a security operation to store said logged usage information”. These claims are indefinite because one of ordinary skill in the art would not understand how “performing a security operation” could be used to store information. Traditionally, security operations are performed to secure information, not store it.

12. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance

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with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 46-62, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Gruse et al. (U.S. 6,389,538 B1) ("Gruse"), in view of Futamura et al. (U.S. 2002/0026582 A1) ("Futamura"), and in further view of Archibald et al. (U.S. 5,825,883 A) ("Archibald").

15. Regarding claims 46 and 54:

b. Gruse discloses the following limitations:

- i. *receiving agent* (End User Device **109**) *for receiving certain digital content* ("content") *from said content provider* ("content provider") (fig. 6 and associated text);
- ii. *rendering device* (End User Device **109** with Player Application **195**) *for rendering said received digital content* (fig. 6 and associated text; and C88, L40 – C89, L35); *and*

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- iii. *logging agent (Player Application 195) for monitoring usage information concerning the actual rendering of said digital content by said rendering agent (C88, L40 – C89, L35);*
- iv. *means for performing a security operation (End User Device 109) (C26, L20-22); and*
- v. *storing said usage information (C88, L40 – C89, L35).*
- c. Gruse is not believed to directly disclose the following limitations:
  - vi. *means for performing a security operation to store said usage information; and*
  - vii. *wherein said usage information includes identification data individually correlating said rendered digital content with a particular user account.*
- d. Futamura, however, teaches the limitations:
  - viii. *means for performing a security operation to transmit usage information (¶ 0459).*
  - ix. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the storing of usage information of Gruse the security operation performed on usage information as taught by Futamura since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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e. Additionally, Archibald teaches the limitations:

x. *wherein usage information includes identification data individually correlating a rendered digital content with a particular user account (fig. 14 and associated text).*

xi. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the usage information that includes identification data individually correlating a rendered digital content with a particular user account of Archibald for the usage information of Gruse. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.

16. Regarding claims 47-53:

f. Gruse/Futamura/Archibald discloses the limitations of claim 46, as described above. Gruse/Futamura/Archibald, further, discloses the following limitations:

xii. *decrypting said digital content prior to the rendering of said digital content (Gruse, C89, L36+);*

xiii. *performing at least part of an authentication of said usage information (Gruse, C26, L20-22);*

xiv. *wherein said usage information is maintained in a log, and said step of performing said security operation further comprises the step of storing said log*



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*in a tamper-resistant environment associated with said client system (Gruse, C82, L53-67; and C88, L40 – C89, L35);*

xv. *wherein said usage information comprises a representation of said rendered digital content and rendering quality information (Gruse, C88, L40 – C89, L35);*

xvi. *wherein said quality information comprises at least one of:*

- (1) bandwidth of said digital content;*
- (2) sample rate said digital content;*
- (3) data compression of said digital content;*
- (4) resolution of said digital content;*
- (5) time information related to rendering of said digital content*  
*(Gruse, C88, L40 – C89, L35); and*
- (6) information of any disruptions during the rendering of said digital content;*

xvii. *wherein said usage information comprises at least one of:*

- (7) identification of a content-usage device rendering said digital content;*
- (8) information on payment of said digital content;*
- (9) time information related to rendering of said digital content*  
*(Gruse, C88, L40 – C89, L35);*
- (10) time information related to transmittal of said digital content from said content provider to said client system; and*

(11) *time information related to reception of said digital content by said client system; and*

xviii. *forwarding said information from said client system to an external trusted party for storage therein as log entry in a usage log (Gruse, C88, L40 – C89, L35).*

17. Regarding claims 55-58 and 60:

g. These claims are understood by the Examiner to be of substantially the same scope as claims 47-50 and 53. Accordingly, claims 55-58 and 60 are rejected in substantially the same manner as claims 47-50 and 53.

18. Regarding claim 59:

h. Gruse/Futamura/Archibald discloses the limitations of claim 54, as described above. Gruse/Futamura/Archibald, further, discloses the following limitations:

xix. *means for tamper-resistantly generating said information (Gruse, C82, L53-67; and C88, L40 – C89, L35); and*

xx. *means for storing said information as a log entry in a log (Gruse, C82, L53-67; and C88, L40 – C89, L35).*

19. Regarding claim 61:

i. Gruse/Futamura/Archibald discloses the limitations of claim 54, as described above. Gruse/Futamura/Archibald, further, discloses the following limitations:

xxi. *a first digital rights management (DRM) agent (Player Application 195), at least partly implemented in said rendering device, having functionality for*

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*enabling rendering of said digital content (C88, L40 – C89, L35; and fig. 10 and associated text).*

20. Regarding claim 62:

j. Gruse/Futamura/Archibald discloses the limitations of claim 54, as described above. Gruse/Futamura/Archibald, further, discloses the following limitations:

xxii. *a second DRM agent implemented in said client system (Secure Container Processor **192**), having functionality for enabling reception of said digital content from said content provider (Fig. 1d and associated text); and*

xxiii. *means for communication between said first DRM agent and said second DRM agent (Inter-application Communication Components **1508**), said first DRM agent comprising means for transferring a first control signal associated with said information to said second DRM agent and said second DRM agent comprises means for processing signal data associated with said first control signal to generate a second control signal, and means for sending said second control signal to said first DRM agent for controlling the digital-content usage process (C83, L36-50; C89, L52-61; and C86, L1-40).*

21. Claim 63, as understood by the Examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Gruse/Futamura/Archibald, and in further view of Official Notice.

22. Regarding claim 63:

k. Gruse/Futamura/Archibald discloses the limitations of claim 54, as described above. Gruse/Futamura/Archibald, further, discloses the limitations:

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xxiv. *wherein said usage information is stored in a database (C88, L40 – C89, L35).*

l. Gruse/Futamura/Archibald is not believed to directly disclose the following limitations:

xxv. *wherein said usage information is stored in a subscriber identity module.*

m. However, the Examiner takes Official Notice that a subscriber identity module (SIM) is old and well-known in the art because they are used to securely store the service-subscriber key used to identify a subscriber on mobile telephony devices (such as computers) and mobile phones.

n. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the SIM of the Examiner's Official Notice for the database of Gruse. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.

23. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the

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claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

24. In light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/or phrases "for", "adapted to", "configured to", or other functional language (*e.g.* see claim 54 which recites "receiving agent for receiving certain digital content") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

25. Although Applicants use "means for" in the claims (*e.g.* see claim 54 which recites "means for performing a security operation"), it is the Examiner's position that the "means for" phrases do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicants concur, the Examiner respectfully requests Applicants to either amend the claims to remove all instances of "means for" from the claims, or to explicitly state on the record why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked. Alternatively, if Applicants desire to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the

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Examiner respectfully requests Applicants to expressly state their desire on the record. Upon receiving such express invocation of U.S.C. 112 6<sup>th</sup> paragraph, the “means for” phrases will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*. Failure by Applicants in their next response to also address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111 (b) or to be non-responsive to this issue entirely will be considered a desire by Applicants NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

### ***Conclusion***

26. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art

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must—at the very least—be aware of and understand the knowledge and information contained within these references.

27. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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Patent Examiner, Art Unit 3621  
October 14, 2008

/ANDREW J. FISCHER/  
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